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30

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10/719,8343

Filing Date

24 November 2003

First Named Inventor

Eastman, Michael Anthony

Art Unit

3727

Examiner Name

Shian T. Luong

Attorney Docket Number

US2005-834

ENCLOSURES (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/
Incomplete ApplicationReply to Missing Parts
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition

Petition to Convert to a
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Power of Attorney, Revocation



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After Allowance Communication to TC

Appeal Communication to Board
of Appeals and InterferencesAppeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify
below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

White-Welker & Welker, LLC

Signature

Printed name

Matthew T. Welker, Esq.

Date

20 July 2007

Reg. No.

53,756

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Date

20 July 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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DOCKET NO. 2005-834

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Michael Anthony Eastman
Serial No.: 10/719,834
Filed: 10/24/2003
For: Compact Mirrored Contact Lens Case

Art Unit: 3728
Examiner: Shian T. Luong

Cover Letter

Commissioner of Patents
Arlington, VA 22313-1450

Sir/Madam:

This is in response to the Notice of Non-Compliant Appeal Brief under 37 CFR 41.37 with a mailing date of June 27, 2007, having a response due by July 27, 2007 (one-month), extendable under 37 CFR 1.136(a) until six months from the mailing date. The notice alleges the following:

- The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order;
- The brief does not contain a statement of the stat of all claims, or does not identify the appealed claims;
- the brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters.; and/or the brief fails to (1) identify, for each independent claim involved in the appeal and for each dependant claim argued separately, every means plus function and step plus function under 35 USC 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the

specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v));

- the brief does not contain copies of the evidence submitted or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix;
- the brief does not contain copies of decisions rendered by a court of the Board in the proceeding as an appendix thereto;
- and section III, status of the claims does not identify claims on appeal
- section V, summary of claimed subject matter must identify and map all independent claims on appeal (claims 1 and 6) to specification by page and line number or paragraph number and page number and/or drawings, if any;
- section IX and X, the evidence appendix and related proceedings appendix are missing from the brief, if there is no evidence or related proceedings, then the indication of “none” should be present at both; and

In this response Applicant has amended the appeal brief to:

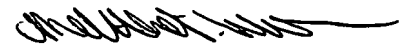
- referred to MPEP 37 CFR 41.37 for the appropriate headings and the brief now contains the items required by MPEP 37 CFR 41.37 under the proper heading and in the proper order.
- The brief now contains a statement of the status of all claims and specifically identifies those appealed. See page 3, lines 11-19.
- clearly point out the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to

the drawings; identifying, for each independent claim involved in the appeal and for each dependant claim argued separately, every means plus function and step plus function under 35 USC 112, sixth paragraph; and set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings. No other changes have been made to the Appeal Brief and Applicant contends that the appeal did and still does contain a concise explanation of the subject matter, but in this revised version includes the required references.

- The appeal brief now contains the required the evidence appendix and related proceedings appendix with the indication of “none” present at both. See pages 22 and 23 of the appeal brief.
- The summary of the claimed subject matter has been revised to map the independent claims, claims, 1, 6, and 10 to the specification by page and line number and drawings.

Applicant respectfully requests the Commissioner to grant the petition for the extension of time of one month, which is required to make this response timely. Appeal Brief should now be in compliance and its review is respectfully requested.

Respectfully submitted,



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Michael Anthony Eastman
Title: Compact Mirrored Contact Lens Case
Appl. No.: 10/719,834
Filing Date: 24 November 2003
Examiner: Shian T. Luong
Art Unit: 3728
Confirmation Number: 7590

BRIEF ON APPEAL

5 Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

10

Under the provisions of 37 C.F.R. § 41.37, this Appeal Brief is being filed
together with a check in the amount of \$500.00 covering the 37 C.F.R. 41.20(b)(2) appeal fee.

The PTO did not receive the following
listed item(s) check #500.00

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REAL PARTY IN INTEREST

The named inventors of the above-captioned application, Michael Anthony Eastman, are the real parties in interest.

5

RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

10

STATUS OF CLAIMS

- | | | |
|----|-------------------|-------|
| 1. | Claims pending: | 1-14 |
| 2. | Claim cancelled: | None. |
| 3. | Claims withdrawn: | None. |
| 4. | Claims rejected: | 1-14 |
| 5. | Claims on appeal: | 1-14 |

15

A full list of the claims is attached in the Claims Appendix.

20

STATUS OF AMENDMENTS

No amendment subsequent to the final Office Action dated September 1, 2006 has been filed. The examiner entered the proposed claim amendments on September 1, 2006 based on the response communication filed by Applicant on 19 July 2006 in response to the non-final Office Action dated February 27, 2006.

25

SUMMARY OF CLAIMED SUBJECT MATTER

The independent claims are Claim 1, Claim 6, and Claim 10. A concise explanation of each of the Independent claims as required under 37 CFR 41.37 follows in this section.

5 Claim 1 is directed to a contact lens case 10 for storing contact lenses comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); one or more reservoirs for storing a contact lens on the top side of said base 15 and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a corresponding cap for each of said reservoirs, said cap being attached to the outer surface 16 of said corresponding reservoir and
10 each cap having its own outer surface 16 and basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface covering for the outer surface 16 of at least one cap wherein said reflective surface covering is of a depth that is less than that of the depth of said basin 12 and is secured within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

 Claim 6 is directed to a contact lens case 10 for viewing insertion or abstraction of
15 contact lens into or from the eye comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); at least one reservoir for storing a contact lens on the top side of said base 15 and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a cap having a basin 12 for said at least one said reservoir, said cap being removeably attached to the outer surface 16 of said at least one said reservoir and having an outer surface 16
20 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface attached to the outer surface 16 of at least one said cap 13 and having a reflective outer surface 16 wherein said reflective outer surface 16 is of a depth that is less than that of the depth of said basin 12 and is secured within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1).

Claim 10 is directed to a contact lens case 10 for viewing insertion or abstraction of contact lens into or from the eye comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); on the top side of said base 15 at least one reservoir for storing a contact lens having an outer surface 16 with threads (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a cap for said at least one said reservoir, said cap being removeably attached to the outer surface 16 of each said reservoir and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface adhered to the outer surface 16 of said at least one said cap (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

The present invention comprises a novel contact lens case 10 that provides a compactly configured storage container for storing contact lenses and a reflective surface for conveniently viewing the insertion and abstraction of the contact lens into or from the eye. (Pg. 1, ll. 4-8) The contact lens case 10 is design so that it can be inexpensively molded out of a polymer. (Pg. 4, ll. 5-6) The contact lens case 10 includes two reservoirs that share a common circular bottom wall (Figs. 1-3). The reservoirs are coaxially oriented and are threaded to accept cylindrical closer caps 13 that seal the reservoirs from loss of fluid and the entry of contaminants. (Pg. 7, ll. 19-21) The cylindrical closure caps 13 engage the opposite ends of the cylindrical body and have inner peripheral surfaces that are coaxially related to the outer peripheral surfaces of the two cylindrical reservoirs of the body. (Pg. 4, ll. 5-18, Pg. 7, l. 10 – Pg. 8, l. 5) Furthermore, the top-end surface of one or more of the cylindrical closure caps 13 has adhered to or embedded into said cylindrical closure cap a reflective surface, a mirror 11 for example, allowing, as its primary function, the user to view the insertion or abstraction of the contact lens into or from the eye. (Pg. 8, ll. 10-18, and Fig. 2).

The user will hold the cylindrical closure cap containing the reflective surface (e.g. mirror 11) directly in front of the eye with one hand while inserting or abstracting the contact lens into or from the same eye with the opposite hand. Thus allowing the user to view, at close proximity, the action heretofore described. (Pg. 4, ll. 15-18).

5

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are whether:

- a) Claims 9, 12, and 14 on the basis of Under 35 USC 112, first and second paragraphs fail to comply with the written description requirement and are indefinite;
- 10 b) The subject matter of Claims 1, 4, and 6 are unpatentable in view of Speshyock, et al. and Girard, or Amet under 35 USC 102; and
- c) The subject matter of Claims 1-14 are unpatentable in view of Ulmer, et al., Girard, Ament, De Meo, and Lin.

With respect to Claims 2-3 and 7-8 Appellant concedes that it is known in the prior art to 15 engage the cap 13 to the base 15 of a contact lens case 10 by threads as disclosed by Lin '314. Appellant respectfully relies on the arguments present below for Claim 1, from which Claims 2 and 3 depend, and Claim 6 from which Claims 7 and 8 depend.

(a) IX. Statement of the Grounds of Rejection

Issue (a). Claims 9, 12 and 14 stand rejected under 35 USC 112, first paragraph, as failing 20 to comply with the written description requirement. With respect to 35 USC 112, first paragraph, Examiner alleges the phrase "compression forces" has no support in the original specification and that adhering or embedding is not an equivalent means of securing. With respect to 35 USC 112,

second paragraph, Examiner alleges that it is not clear what “embedding means or compression forces is exerted toward the center of the depth of the basin 12” means in context of the invention.

Issue (b). Examiner alleges that the subject matter of Claims 1 and 4 are unpatentable in view of Speshyock, et al. and Girard, or Ament under 35 USC 102. The Examiner’s position is that the claim language does not differentiate the present invention from those in the prior art and that Speshyock’s cover and base 15 have met all the claim limitations of claim 1. There is no analysis or reasoning for the rejection of the claim elements found in Claims 2-4.

Issue (c). Claims 1-14 are unpatentable in view of Ulmer, et al., Girard, Ament, De Meo, and Lin. Examiner alleges, for claim 6 and 1-14 in general, that under *In re Oetiker*, that there is no reason to provide a citation or example that teaches a claim element, and that a statement that such is obvious is sufficient to find obviousness.

With respect to claims 1-14 in general Examiner again alleges that it would be obvious to secure in the claimed manner, and that it is within the discretion of the Examiner to “interchange the terms ‘container’ and ‘caps’ as long as the structure fits the terms.”

With respect to claims 1, 4, and 5, Examiner alleges that the claimed invention is unpatentable over De Meo in view of Girard and/or Ament stating “De Meo *appears* to have a reflective surface” and that Ament teaches “a mirror spun or crimped or suitably secured to the cap”, both without references in the citations to where these claim elements are taught or suggested.

GROUPING OF CLAIMS

Claim 1 is an independent claims to which Claim 2, 3, 4, 5, and 13 depend. Claim 6 is an independent claim to which claims 7, 8, 9, 12, and 14 depend. Claim 10 is an independent claim to which Claim 11 depends.

All claims are directed to a compactly configured contact lens case 10 for storing contact lenses which includes at least one mirrored closure cap wherein the mirror 11 is viewable as the top surface of the closure cap. (Pg. 1, ll. 4-8, and Claims) The contact lens case 10 includes two reservoirs that share a common base 15 and are coaxially oriented and threaded to accept
 5 cylindrical closure caps 13 that engage the opposite ends of the cylindrical body and have inner peripheral surfaces that are coaxially related to the outer peripheral surfaces of the two cylindrical reservoirs of the body. (Pg. 7, ll. 19-21, Figs. 1-3) The mirrors' 11 primary function is to provide a close proximity view of the insertion or abstraction of the contact lens into or from the users' eye. The user will hold the mirrored closure cap directly in front of the eye with one hand, while
 10 performing the act of inserting or abstracting the contact lens into or from the eye with the opposite hand. (Pg. 4, ll. 15-18).

ARGUMENT

Issue (a). Claims 9, 12, and 14 comply with 35 USC 112, first and second paragraphs as
 15 they specification supports the claim elements and the claim elements are clearly defined either by their plain language definition or as defined in the specification.

Claims 9, 12 and 14 stand rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

Claim 9 is directed to a contact lens case 10 wherein said reflective surface is secured
 20 within said basin 12 toward the center of the depth of said basin 12 against the depth of said reflective surface. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14). Claim 12 is directed to a contact lens case 10 wherein said reflective surface is secured within said basin 12 by embedding means toward the center of the depth of

said basin 12 against the depth of said reflective surface. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14). Claim 14 is directed to a contact lens wherein the securing means of the reflective surface within the basin 12 are the compression forces created by the depth of said basin 12 against the depth of said reflective surface where said reflective surface has a slightly larger diameter than said basin 12. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14).

Examiner claims the phrase “compression forces” has no support in the original specification. Appellant concedes that the application does not explicitly state that the mirror 11 is retained within the depth of the basin 12 with a “compression force”.

Appellant’s position is that the “embedding” and “adhesion” methods and means taught by the specification are well known in the manufacturing prior arts and that “embedding” involves a process comprising the steps of placing a slightly oversized object into a recess on the surface of another object, wherein by forcing the slightly oversized object into the recess, compression forces are created by the depth of the recess in order to retain the slightly oversized object in place (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14). This process of embedding, which inherently includes “compression forces”, is well known process in the manufacturing arts.

Embed is defined as: 1. to fix into a surrounding mass: to embed stones in cement; or 2. to surround tightly or firmly; envelop or enclose: Thick cotton padding embedded the precious vase in its box. In the claims the use of “securing means”, “embedding means”, and “compression forces” are defined in the specification as embedding. Embedding is one manner of securing the mirror 11 to the cap, and the use of “compression forces” which are created by placing the mirror 11 within the recessed area of the cap, the basin 12, whose walls are then used

“to surround tightly or firmly; envelop or enclose”, the definition of embed, which results in the compression forces used to retain the cap.

Examiner alleges, “the step of embedding does not necessarily require an compression force toward the center of the basin 12.” In the absence of a compression force created by

5 forcing an oversized reflective surface into the basin 12, there would be no means of securing the reflective surface to the basin 12, it would simply be sitting in a recess and would fall out when tilted at an angle or turned over. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14) To secure a reflective surface within a basin 12 of equal or larger size, and adhesive would be needs, while forcing a slightly larger reflective surface into a
10 basin 12, resulting compression forces between the depths of their respective sides acts to secure the reflective surface within the basin 12. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14)

Claims 9, 12 and 14 stand rejected under 35 USC 112, first paragraph, as being indefinite and not clear what compression force is exerted toward the center of the depth of the basin 12. The
15 present invention eliminates the need to use a glue or other adhesive product, instead teaching a cap with a basin 12 that has a larger depth than the reflective surface and is slightly smaller than that of the reflective surface that is to be inserted, this is Embedding. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14) The reflective surface is inserted into the basin 12 and is held in place by the compression forces exerted against its depth
20 by the depths of the basin 12 walls. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14) During the manufacturing process the reflective surface, which is slightly larger than the basin 12 opening, is forced into the basin 12 under pressure.

Once located in the basin 12, the reflective surface’s smaller depth allows it to be held in place

by the compression forces of the polymer, which is slightly stretched. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14)

Issue (b). The subject matter of Claims 1, 4, and 6 is patentable in view of Speshyock, under 35 USC 102. With respect to claims 1, 4, and 6, Examiner cites '281, stating that it discloses a contact lens case 10 comprising: a base 15 (verified by Fig 1, '281, item 1); a cover (verified by Fig 1, '281, item 2); at least one reservoir on the top side of the base 15 having an outer surface 16 (verified by Fig 2, '281); a cover having its own outer surface 16 and attachable to the base 15 via its own threads (verified by Fig 1, '281 item 18); a reflective surface covering said outer surface 16 of said cover (verified by Fig 1, '281, item 5); and said cover having a basin 12 and the reflective surface has a depth less than the basin 12 depth.

Claim 1 is directed to a contact lens case 10 for storing contact lenses comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); one or more reservoirs for storing a contact lens on the top side of said base 15 and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a corresponding cap for each of said reservoirs, said cap being attached to the outer surface 16 of said corresponding reservoir and each cap having its own outer surface 16 and basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface covering for the outer surface 16 of at least one cap wherein said reflective surface covering is of a depth that is less than that of the depth of said basin 12 and is secured within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

With respect to claims 1 and 4 anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires disclosure as

arranged in the claim. See. *W.L. Gore & Associates v. Garlock, Inc.* Claims 1, 4, and 6 were amended to include the language “in combination” explicitly making the claims a specific combination of the elements claimed therein.

Here ‘281 refers to a “cover.” The Examiner refers to this cover containing a mirror 11.

5 In Fig. 2 of ‘281, the cover that ‘281 refers to is removed, showing the 'lens holding portion.' The 'lens holding portion' is the contact lens case. In the first claim of ‘281, it also states the invention has a contact lens holding means, which includes a base 15 and cover that can have a mirror 11, and the invention has a contact lens storage means, which is the case in the present invention. They are two separate and distinct parts of ‘281. ‘281 teaches a mirrored cover case
10 for a contact lens case, while the present invention on teaches a contact lens case 10 wherein mirrors 11 are secured to the removable caps 13, not to another case.

Column 3, lines 70-75 of ‘281 discusses the cover; base 15; and fluid-containing compartments bounded by bottom, sidewall and removable caps 13. The cover is separate from the removable caps 13 of the fluid containing compartments. Column 5, line 13 of ‘281 states
15 "all the embodiments utilize the same lens holding cap element." This lens holding cap element is not mirrored. The cover can be mirrored. The word "mirror" appears only once in ‘281 in column 3 line 49.

The Examiner's description in the office action closely follows Appellant's description on page 2 of the present application and is not supported by ‘281 or any other cited reference. The
20 mentioned mirrored “cover” in Examiner's rejections cannot possibly refer to ‘281 as the 'cover' in ‘281 is not a threaded connection to the base 15. The present invention describes a mirrored cover (cap) for a contact lens case 10. ‘281 merely describes a mirrored cover for the cover for a contact lens case. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3)

The sixth element in Appellant's claims is not taught, suggested, or anticipated by '281.

Examiner provides no citation to the teaching of a cover or cap having a basin 12 wherein the reflective surface has a depth less than the basin 12 depth in '281. '281 teaches a mirrored case that holds a contact lens case (see column 3, line 48), it is *not* a mirrored contact lens case 10 but a case for a contact lens case.

Appellant emphasized the differences between the present application and the teaching of '281 and the claim language of such differentiations of the present application. Specifically, the present application is narrowly focused on a basin 12 on a cap that covers the area for storing a contact lens and is not a case for a contact lens case 10 as that taught by '281. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3). Appellant's invention incorporates a reflective surface on a contact lens case 10 in a unique and non-obvious way (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1), while '218 merely teaches a case comprising two parts, which allow for the storage of a contact lens case and other materials, with one part of the case having a reflective surface. There is no mention of teaching in '218 of how to secure the reflective surface to a case, and '281 does not teach the use of a basin 12 or any specific size. Appellants point is confirmed by Examiner's position in the office action when Examiner states "mirror appears to be attached" (emphasis added).

Claim 6 stands rejected under 35 USC Section 102(b) as being anticipated in view of *Speshyock et al.* (U.S. 3,211,281) hereafter referred to as '281. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires disclosure as arranged in the claim. See. *W.L. Gore & Associates v. Garlock, Inc.* By Examiner's own words, and lack thereof, it is clear that '281 does not teach the

use of a basin 12 for receiving a mirror 11. Examiner has made no citation to such a teaching in ‘281 and ever further, in under Examiner’s Claim Rejections – 35 USC Section 102, Examiner writes “but in the event that it is not attached” clearly an indication the Examiner can not support or is not sufficiently certain of the required disclosure under 35 USC 102 in ‘281.

5 Claim 6 is directed to a contact lens case 10 for viewing insertion or abstraction of contact lens into or from the eye comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); at least one reservoir for storing a contact lens on the top side of said base 15 and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a cap having a basin 12 for said at least one said reservoir, said cap being removeably
10 attached to the outer surface 16 of said at least one said reservoir and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface attached to the outer surface 16 of at least one said cap and having a reflective outer surface 16 wherein said reflective outer surface 16 is of a depth that is less than that of the depth of said basin 12 and is secured within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-2, 4).

15 Furthermore anticipation will not be found when the prior art is lacking or missing a specific feature or structure of the claimed invention. Here, as previously discussed, ‘281 does not disclose the use of basin 12 to secure the mirrored surface using embedding techniques or compressive pressure from the side wall of a basin 12 as claimed by Appellant. Additionally, ‘218 does not teach or suggest the specific relationship of the reflective surface and the basin 12,
20 such that the basin 12 wherein the reflective surface has a depth less than the basin 12 depth is required. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-2, 4). Withdrawal of this rejection is respectfully requested.

Issue (c). The subject matter of Claims 1-14 is patentable in view of Ulmer, et al., Girard, Ament, De Meo, and Lin. Again for complicity, a prima face case of obviousness is established when an examiner provides: one or more references, that were available to the inventor and, that teach, a suggestion to combine or modify the references, the
5 combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Accordingly, an Appellant who is able to prove that the Examiner has failed to establish any one of these elements will prevent the prima facia case of obviousness form being established.

With respect to Claims 1-11, Examiner alleges that '780 discloses "a least one reservoir
10 on the top side of the base 15 and having an outer surface 16 with threads;" A cap for the reservoir is attached to the outer surface 16 of the reservoir by threads." This is a misstatement or misunderstanding of the teaching of '780. '780 teaches a cap 18 with a base 15 fixed in such a manner that the cap 18 and base 20 may be removed from a container 14 with the base 20 attached. It is the container 14, which has a mirrored surface 60, not the cap 18. '780 does not
15 suggest or teach the use of a mirrored surface on the cap 18, it only teaches the use of a mirrored surface 60 on the container 14. Thus, Examiner's arguments are not supported.

The cap 18 of '780 is separable from the lens storing area or container 14, which is the basis of improvement for the present invention. The present invention allows a user to remove a cap and use a mirror 11 located on the cap to assist in the asserting of a contact into the eye (Pg.
20 4, ll. 6-18) while '780 would require a user to handle and wave around the container 14 while using the mirrored surface 60 of the container 14, which is more difficult to hold steady due to its weight and size with also the potential for spilling the cleaning and sterilization fluid from the container 14.

Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by '579 and '452 for lipstick cases for use on a contact lens case of '780. Also, with respect to Examiner's allegation that it would be "obvious to secure the mirror 11 to present if from inadvertent removal from the basin 12," again, how does the Examiner know that '780, '579, or '452 didn't contemplate removal? The Examiner can *not* claim it is obvious under '780, '579, or '452 to attach the mirror 11 due to its lack of teaching and the possibility of a desirable effect for removability or attachment at a different location.

With respect to Claims 1, 4, and 5 which stand rejected under 35 USC 103(a) as being unpatentable over De Meo. ('477) in view of Girard ('597) and/or Amet ('452) Appellant and/or Official Notice respectfully disagrees.

Claim 1 is directed to a contact lens case 10 for storing contact lenses comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); one or more reservoirs for storing a contact lens on the top side of said base 15 and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a corresponding cap for each of said reservoirs, said cap being attached to the outer surface 16 of said corresponding reservoir and each cap having its own outer surface 16 and basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface covering for the outer surface 16 of at least one cap wherein said reflective surface covering is of a depth that is less than that of the depth of said basin 12 and is secured within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

Claim 4 is directed to the contact lens case 10 of claim 1, wherein said outer surface 16 of at least one said cap includes said basin 12. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

Claim 5 is directed to the contact lens case 10 of claim 4, wherein said reflective surface is

adhered within said basin 12, and having a reflective outer surface 16. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-2, 4-5).

Claim 10 is directed to a contact lens case 10 for viewing insertion or abstraction of contact lens into or from the eye comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); on the top side of said base 15 at least one reservoir for storing a contact lens having an outer surface 16 with threads (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a cap for said at least one said reservoir, said cap being removeably attached to the outer surface 16 of each said reservoir and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface adhered to the outer surface 16 of said at least one said cap (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

With respect to independent claims, 1, 6, and 10, Appellant concedes that '477 does teach what could be called a "standard contact lens case" which is well known in the prior art, and is incorporated in the present invention that comprises, at least one reservoir, a base 15 with an outer surface 16, and an attached cap. Examiner's allegation that '477 "appears to have a mirrored surface" is incorrect. The title, claim and description of the Figures in '477 is absent of any reference to the type of surface or materials. Additionally, the figures themselves show no reflective surfaces. Examiner's position is completely nonsensical in view of all the cited prior art made of record in this prosecution and Appellant's application, all of which clearly illustrate reflective surfaces in their line drawings, while '477 shows one surface appearance for the entire contact lens case.

Official Notice is also not sufficient to supply motivation for modifications. The factual inquire to modify must be based on objective evidence of records. *Ex parte Humphreys* holds that when an Examiner does not provide specific reasons to support the obviousness rejection,

they have failed to establish the prima facie case of obviousness. Here Examiner fails to states the specific element or motivation that is being taken. If it is “to secure the mirror within the cap....” in view of ‘570 or ‘452, then Examiner’s statements are inconsistent as Examiner first argued Official Notice in a previous Office Action, but now argues “obviousness” without being
5 able to cite any prior art references.

With respect to Claim 6, Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by ‘579 and ‘452 for lipstick cases for use on a contact lens case. Also, Examiner’s allegation that it would be “obvious to secure the mirror 11 to present if from inadvertent removal from the basin 12,” how does the Examiner know that ‘281, ‘579, or ‘452
10 didn’t contemplate removal? The Examiner can *not* claim it is obvious or use hindsight under ‘281, ‘579, or ‘452 to attach the mirror 11 due to its lack of teaching and the possibility of a desirable effect for removability.

With respect to Claims 2-3 and 7-8 Appellant concedes that it is known in the prior art to engage the cap to the base 15 of a contact lens by thread as disclosed by Lin ‘314. Appellant
15 respectfully relies on the same arguments for Claim 1, from which Claims 2 and 3 depend, and Claim 6 from which Claims 7 and 8 depend.

With respect to Claims 2, 3, 4, 5, and 13, Appellant respectfully relies on the same arguments for Claim 1 from which they depend. With respect to Claims 7, 8, 9, 12, and 14 depend, Appellant respectfully relies on the same arguments for Claim 6 from which they depend. With respect to
20 Claim 11, Appellant respectfully relies on the same arguments for Claim 10 from which it depends.

Appellant contends that there is no contact lens case or prior art that teaches or claims a mirror 11 embedded in one of the caps 13. While Appellant concurs with Examiner that there

are mirrors embedded in cases for contact lens cases or makeup cases, Appellant respectfully disagrees that the cited prior art teaches or make obvious the present invention.

Claims 6-9 represent similar embodiments of the case as Claims 1-5, but instead of gluing the mirror 11 into the basin, the mirror 11 is held into the basin by the basin walls. In other words, the mirror 11 snaps into the basin and the basin itself holds the mirror 11 in place by compression forces of the molded plastic basin walls and case (depths). For manufacturing and cost reasons this is the way the case is made now and sold. The mirror 11 can be snapped into the basin, forced out of the basin, and then snapped back into the basin.

CLAIMS APPENDIX

1. A contact lens case for storing contact lenses comprising in combination:

a base having a top side;

one or more reservoirs for storing a contact lens on the top side of said

5 base and having an outer surface;

a corresponding cap for each of said reservoirs, said cap being attached to
the outer surface of said corresponding reservoir and each cap having its own
outer surface and basin; and

a reflective surface covering for the outer surface of at least one cap

10 wherein said reflective surface covering is of a depth that is less than that of the
depth of said basin and is secured within said basin.

2. The contact lens case of claim 1, wherein said outer surface of said reservoir includes threads.

15 3. The contact lens case of claim 2, wherein each said cap has an inner surface that includes
threads adapted to engage said threads of said reservoir.

4. The contact lens case of claim 1, wherein said outer surface of at least one said cap includes
said basin.

20

5. The contact lens case of claim 4, wherein said reflective surface is adhered within said basin,
and having a reflective outer surface.

6. A contact lens case for viewing insertion or abstraction of contact lens into or from the eye comprising in combination:

a base having a top side;

at least one reservoir for storing a contact lens on the top side of said base and having an

5 outer surface;

a cap having a basin for said at least one said reservoir, said cap being

removeably attached to the outer surface of said at least one said reservoir and

having an outer surface; and

a reflective surface attached to the outer surface of at least one said cap and having a

10 reflective outer surface wherein said reflective outer surface is of a depth that is less than that of the depth of said basin and is secured within said basin.

7. The contact lens case of claim 6, wherein said outer surface of said reservoir includes threads.

15 8. The contact lens case of claim 8, wherein said cap has an inner surface that includes threads adapted to engage said threads of each respective said reservoir.

9. The contact lens case of claim 8, wherein said reflective surface is secured within said basin toward the center of the depth of said basin against the depth of said reflective surface.

20

10. A contact lens case for viewing insertion or abstraction of contact lens into or from the eye comprising in combination:

a base having a top side;

on the top side of said base at least one reservoir for storing a contact lens having an outer surface with threads;

a cap for said at least one said reservoir, said cap being removeably attached to the outer surface of each said reservoir and having an outer surface;

5 and

a reflective surface adhered to the outer surface of said at least one said cap.

11. The contact lens case of claim 10, wherein said cap has an inner surface that includes threads adapted to engage the threads of each respective said reservoir.

10

12. The contact lens case of claim 8, wherein said reflective surface is secured within said basin by embedding means toward the center of the depth of said basin against the depth of said reflective surface.

15 13. The contact lens case of claim 4, wherein said reflective surface is embedded within said basin, and having a reflective outer surface.

14. The contact lens case of claim 9, wherein the securing means of the reflective surface within the basin are the compression forces created by the depth of said basin against the depth of said reflective surface where said reflective surface has a slightly larger diameter than said basin.

20

EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.

5

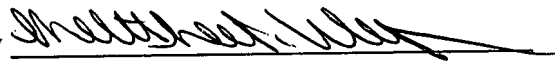
SUMMARY

For the foregoing reasons in the Arguments section, it is submitted that the Examiner's rejections are erroneous, and reversal of the applied rejections is respectfully requested.

5

Respectfully submitted,

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By 

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